REMARKS

Reconsideration of the above-identified application in view of the present amendment is hereby requested.

The allowance of claims 10-17 is noted with appreciation. The indicated allowability of claims 4-6 has resulted in allowable claim 4 being rewritten in independent form. Allowable claim 6 has also been rewritten as independent form. Accordingly, claims 4, 5, 6, and 10-17 are believed allowable.

Claims 26-33 have been added and these claims find support in the method of forming a deformed reinforcing bar connection which includes the steps of cutting the bar to length and then cold working the bar end by radially compressing and cold forming, then forming a thread on the compressed bar end with the threads being shorter than the length of the cold formed section, all as described in connection with the A, B and C dimensions of Figures 1 and 2. The radial compression is described in the description relating to Figures 4, 5 and 6. Reference may be had to Page 7 of the Specification and to the discussion of the cold formed section projecting beyond the mouth of the sleeve.

These claims are submitted as allowable for the same reasons as the Examiner has indicated in the section of the action relating to reasons for allowance at the bottom of page 4.

Claim 1 has been amended also to bring it more clearly within the reasons for allowance indicated and now sets forth that the threads are substantially shorter than the cold formed section.

With the above, reconsideration of this application is respectfully requested.

The Examiner has rejected claims 1-3 as anticipated by Kies, U.S. Patent 4,870,848. Although the text of the rejection refers to Howlett, U.S. Patent 4,752,159, it is not believed that this reference is actually applied, since otherwise it wouldn't be an anticipation rejection.

There is only one sentence in Kies relating to the rejection and that sentence is: "A tapered surface is formed on the bar end prior to roll forming of such threads as by hot or cold forging or by cutting." This describes the tapered end 20 seen in Figure 2 prior to the roll forming of the threads.

Kies does not disclose how the cold forming takes place nor does he describe a process where the threads formed are substantially shorter than the cold formed section. Accordingly, claim 1 as amended, as well as dependent claims 2 and 3 are submitted as allowable.

The Examiner has rejected claims 8 and 9 as obvious over Kies in view of Birks and Leonhardt. Both of the secondary references show compression dies which squeeze a malleable sleeve onto deformed bar to lock onto the deformations and form a splice sleeve. Claim 8 depends on claim 7 which requires flattening of the deformations. If indeed the deformations of Birks or Leonhardt were flattened or made to disappear, neither would work.

The authorities on the subject of whether it would be obvious to destroy or render inoperative a prior device are pretty straight forward.

In *In re Schulpen*, the CCPA indicated:

> Rather than being made obvious by the reference, such modification would run counter to its teaching by rendering the apparatus inoperative to produce the disclosed tire patches. *In re Schulpen* 157 USPQ 52, 55, (CCPA 1968).

In *Ex Parte Hartmann*, 186 USPQ 366 at 367, (1974) the PTOBA held that references cannot properly be combined if the effect would destroy the invention on which one of the reference patents is based. These decisions by

the CCPA and Board of Appeals were precursors of the well known decision by the Federal Circuit found in *In re Gordon* 221 USPQ 1125, 1127 (Fed. Cir. 1984), involving the inoperative up-side-down oil filter.

This Federal Circuit decision is perhaps best summarized in footnote 12 found in the subsequent more recent case of *In re Fritch* 23 USPQ 2d 1780, at 1783 (Fed. Cir. 1992). Such footnote states:

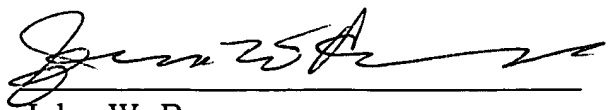
> [12]This court has previously found a proposed modification inappropriate for an obviousness inquiry when the modification rendered the prior art reference inoperable for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In addition to *In re Fritch, Gordon* has been followed in *In re Kramer* 18 USPQ 2d 1415, 1416 (Fed. Cir. 1991 unpub.), *In re Chu* 36 USPQ 2d 1089, 1094 (Fed. Cir. 1995), and in *Bausch & Lomb Inc. v. Barnes-Hind/Hydrocurve Inc.* 10 USPQ 2d 1929, 1934 (N.D. Calif. 1989).

In view of the foregoing this application is submitted as in condition for final allowance and early action to that effect is submitted.

Should any deficiencies or overpayments occur in the filing fees of the subject amendment, authorization is hereby given to charge Deposit Account Number 18-0988.

Respectfully submitted,
RENNER, OTTO, BOISSELLE & SKLAR



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